

REMARKS

In the Final Office Action mailed June 11, 2003, the Examiner rejected claims 1-5, 7-13 and 15-22. Applicants disagree with the Finality of the current Office Action and request the issuance of a new non-final Office Action based on the remarks made herein. Notwithstanding, Applicants have fully responded to the Office Action. Claims 1-5, 7-13 and 15-22 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

Response to Finality of Office Action

In the current Office Action, the Examiner has made this action Final. Applicants believe that this was premature in view of MPEP §706.07(a) of the MPEP. For the Examiners convenience, that section states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

This section of the MPEP clearly provides an exception clause to making of a Final Action when:

- i. the Examiner introduces a new ground rejection, and
- ii. when the new ground is not necessitated by
 - a. applicant's amendment of the claims, or
 - b. an IDS filed under 37 CFR 1.97(c).

First, Applicant notes that in section 6 of the Office Action, page 6, the Applicant's arguments in response to the previous Office Action were "moot in view of the new ground(s) of rejections". As such, the Examiner has raised a new ground of rejection and thus, the first portion of the exception clause has been satisfied.

Second, the new grounds of rejection was not based on the applicants amendments nor were they based on any reference provided in an IDS filed under

37 CFR 1.97(c). The only amendment to the existing claims was the removal of the term "second" from claim 1 to simply conform to 35 USC §112 requirements, as pointed out by the examiner in the Office Action dated December 26, 2002. Also, all of the references cited in the current Office Action were not cited by the Applicants in any IDS but instead cited by the Examiner in the last two Office Actions.

As such, the new grounds of rejections were not based on the applicants amendment to any claim or on any reference filed under 37 CFR 1.97(c). Applicant hereby request removal of the finality of the current Office Action and the issuance of a new non-final Office Action.

Notwithstanding, Applicants have fully responded to the current Office Action.

Response to rejection based on 35 USC §103(a)

Claims 1, 2, 5, 7-10, 13, 15-17 and 19 were rejected based on Ogawa, U.S. Patent 4,498,433, in view of Matsushita et al., U.S. Patent 5,717,009. Claims 3, 4, 11, 12, 18 and 21 were rejected based on Ogawa in view of Matsushita et al., and further in view of Tani et al., U.S. Patent 5,250,629. Claim 20 was rejected based on Ogawa in view of Matsushita et al., and further in view of Drauglis et al., U.S. Patent 4,374,717. Claim 22 was rejected based on Ogawa in view of Berger et al., U.S. Patent 4,682,672, and further in view of Matsushita et al. As such, the bases of all of the rejections required the combination of Ogawa in view of Matsushita et al. These rejections are traversed.

Turning first to the Ogawa patent, the objective of the Ogawa patent is to provide automotive components for "absorbing vibrations transmitted from an engine" for the purpose of "decreasing noises resulting from surface vibrations." See the Ogawa abstract. In order to achieve the vibration reduction, the automotive components require a specific combination of materials that includes a crosslinked thermoset resin and fibers. See column 7, lines 26-35.

In one embodiment, Ogawa teaches that the automotive component may be an oil pan. In this embodiment, an oil pan is configured with the above cross-linked resin matrix, which necessitates an additional layer for the preventing engine oil from penetrating through the fiber layer. The oil pan is then attached to the engine by

means of bolts, retaining brackets and a gasket. No other means or variants of attachment of the oil pan to the engine is taught or suggested in Ogawa.

As the Examiner has correctly pointed out, Ogawa fails to teach "an adhesive as an attaching and sealing means in lieu of the gasket and fastening device". Office Action dated June 11, 2003, page 3, section 2, lines 1-2. The Examiner further points out that Ogawa fails to teach claim 7, "a primer contacting the adhesive" (Id., at line 2); claim 3, "the oil pan being made of polyamide and syndiotactic polystyrene"; claim 4, the oil pan being made of "an injection molded filled plastic blend of nylon 6,6 and syndiotactic polystyrene" (Id., page 3, section 3, lines 6-7); claim 20, the oil "pan having a plasma coating" (Id., page 4, section 4, lines 5-6); and claim 22, further comprising "clips on the oil pan to engage cutout portions of the engine" (Id., page 5, section 5, lines 7-8). Implicitly, the examiner further acknowledges that Ogawa fails to teach the oil pan comprising of a thermoplastic. Id., page 4, section 3, lines 4-7. In short, by virtue of the sole common feature in Ogawa of a plastic oil pan (albeit a thermoset), the Examiner seeks to extrapolate a case of obviousness.

In contrast, the objective of the present invention is to provide an oil pan assembly, particularly including a thermoplastic oil pan in certain claims, which is assembled using an adhesive. As such, the present invention overcomes the drawbacks of previous oil pan assemblies such as the combination of the fabrication of the oil pan housing having one or more metal components; the use of fasteners to assemble the oil pan assembly; and the use of intermediate disposed gasket. By avoiding these design restrictions, the oil pan assembly of the present invention provides a simple and elegant approach to oil pan assemblies, neither taught nor suggested by the prior art.

In short, the Examiner fails to establish a *prima facie* case of obviousness in view of Ogawa, particularly in view of the concessions of numerous missing features, and the lack of motivation to bond a plastic (especially a thermoset plastic) oil pan with an adhesive, such as in the combination as a whole that is claimed by applicants.

Even in the context of the secondary references cited by the Examiner, Applicants are of the opinion that the Examiner has failed to meet the criteria for a

prima facie case of obviousness, which requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP §2143.

More specifically, Applicants are of the opinion that there is no motivation, found in Ogawa, to borrow from the teachings of any of the secondary references to account for the acknowledged deficiencies of the Ogawa teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1431 (Fed. Cir. 1990). Furthermore, “teachings of references can be combined only if there is some suggestion or incentive to do so.” *ASC Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Matsushita cannot be properly combined with Ogawa. The Examiner relies upon a single passage in Matsushita at column 11, lines 19-27, which states:

According to the present invention, it is possible to obtain an adhesive composition which has rapid curing property, is cured to a deep portion at ordinary temperature in a short time, exhibits excellent adhesiveness to a wide range of various adherends in a short time and does not suffer from catalyst poison. The composition of the present invention is suitably used for an adhesive or sealing material, a FIPG sealing material, etc. of parts of automobiles, parts of electric and electronic instruments, etc.

The Examiner has failed to show how such passage offers any motivation to combine with Ogawa, a reference itself deficient of any teaching of adhesive.

Applicants believe that this passage, and the remainder of the patent, neither teaches nor suggests that an adhesive may be used on the mating surfaces of an oil pan and engine component to form an oil pan assembly. Furthermore, the combined references fail to even teach that an adhesive is used to adhere a plastic oil pan with an engine component to form an oil pan assembly. As stated in the MPEP 2143.03, “To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, “All words in a claim must be considered in judging

the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The Matsushita patent, in combination with the Ogawa patent, does not teach or suggest the use of adhesives for joining the mating surfaces of a plastic oil pan with an engine component to form an oil pan assembly, particularly the combination, as a whole, as recited in claims 1, 9 and 22. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

In short, the Examiner's rejection of claims in view of the combination of Ogawa and Matsushita is believed improper and withdrawal of the rejection is respectfully requested.

As to Tani et al., Applicants are of the opinion that Tani et al., as with the Matsushita reference, is not combinable with Ogawa because there is no motivation to combine the two references.

Tani et al., teaches a material which is "widely utilized in a variety of application field including film, sheet, especially stampable sheet, container, packaging material, automobile parts, electrical and electronic parts, etc." see abstract. Applicants believe that the above passage does not direct one skilled in the art to replace the material used in Ogawa with the material found in Tani.

Of note, the Examiner rejected claim 7 and 16 by asserting, "providing a primer for adhesion is known in the chemical bonding art and such utilization of the practice would be within the level of ordinary skill in the art. See Pluddemann, U.S. Patent 4,961,967." Office Action, page 3, section 2, lines 10-13. However, the Applicants contend that the Examiner must show some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the reference. See *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). As such, this burden still remains with the Examiner to provide this teaching.

The Examiner also incorrectly rejected claim 20 by asserting that the plasma coating of Drauglis et al. can be combined with Ogawa and Matsushita to somehow form the claim as a whole.

The Objective of Drauglis et al. appears to the improvement of the final appearance or adhesion of a chromium layer by applying a plasma underlying coat. In contrast, the present invention provides a plasma coating for reducing the fugitive

hydrocarbon emission from an automotive vehicle through the oil pan. As such, Drauglis et al. is a non-analogous reference because the problems being solved are completely different (e.g. improved methods of applying a chrome layer versus the prevention of hydrocarbon emissions) and the reference should not be combined with Ogawa and Matsushita.

"Any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) (underlining added). Applicants believe that the Examiner has inappropriately relied upon Applicants' teaching as the sole approach to reconstructing the prior art to arrive at the claimed combination as a whole. This hindsight approach is not appropriate and does not satisfy the Examiner's burdens to set forth a *prima facie* showing of obviousness. In short, Applicants believe the present rejections are improperly maintained and should be withdrawn.

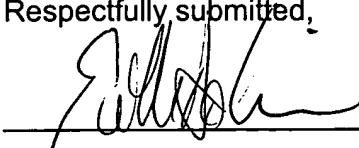
CONCLUSIONS

In view of Applicants' remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 593-9900.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

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